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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,088	08/03/2001	Shlomo Antica	JJA-0105	8671

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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 04/11/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,088

Applicant(s)

ANTICA ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 112***

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for those phosphate ester base fluids which will successfully lubricate hydraulic systems operating at pressures of about 4000 psi or higher, does not reasonably provide enablement for phosphate ester base fluids that do not successfully lubricate hydraulic systems at such high pressures. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use any phosphate ester hydraulic fluid, including those that will not work successfully at 4000 psi and higher, as the invention commensurate in scope with these claims. In the remarks filed 5 March 2003, applicants noted that Deetman shows in Table 11 several phosphate ester hydraulic fluids and argue that they have discovered that some of these fluids will meet performance requirements at high pressure and some will not. However, it is not clearly set forth in the specification which hydraulic ester base fluids will meet the performance requirements at high pressure and which will not, since applicants teach in the specification on page 5 that the phosphate ester base stocks of Deetman are suitable in this invention. Applicants' claims are open to experimentation to determine which base stocks will meet the limits of the claims. Correction/clarification is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deetman (5,464,551).

Applicants' arguments filed 5 March 2003 have been fully considered but they are not persuasive. As set forth in the previous office action, Deetman discloses an aircraft hydraulic fluid composition which comprises a fire resistant phosphate ester base stock comprising between about 10% and about 100% by weight of a trialkyl phosphate, between about 0% and about 70% by weight of a dialkyl aryl phosphate, and from about 0% to about 25% by weight of an alkyl diaryl phosphate. The alkyl substituents of the phosphates contain between about 3 and 8 carbon atoms, preferably between 4 and 5 carbon atoms, and most preferably are isoalkyl groups such as isobutyl and isopentyl. The fluid composition additionally comprises an acid scavenger, an anti-erosion additive, a viscosity index improver, and an antioxidant. See column 2, line 26 to column 3, line 21. The examiner maintains the position that the aircraft hydraulic fluid composition of Deetman clearly meets the limitations of the claimed hydraulic fluid composition. Applicants' claims are drawn to a method for operating and lubricating hydraulic systems at a pressure of about 4000 psi by employing a phosphate ester hydraulic fluid composition which is encompassed by the applied prior art. The examiner maintains the position that it would have been obvious to have employed a known aircraft hydraulic fluid in such a hydraulic system. Although Deetman does not specify a pressure at which the hydraulic fluid should operate, Deetman teaches that the hydraulic fluid exhibits improved hydrolytic and

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oxidative stability when used in aircraft applications. Applicants teach in the specification that phosphate ester based functional fluids useful as aircraft hydraulic fluids have been described in the Deetman reference and that standard operating pressure for aircraft hydraulic systems is nominally 3000 psi. The examiner maintains the position that the stability properties of the phosphate ester hydraulic fluid composition of Deetman at such elevated operating pressures are inherent, that is, the known stability properties at such elevated pressures were always present but went unrecognized. The recitation of a characteristic inherent in a composition cannot serve as a basis upon which to predicate the issuance of a patent to a known method of using the composition. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974).

Additionally, as set forth above, the hydraulic fluids of Deetman are taught to exhibit improved hydrolytic and oxidative stability *when used in aircraft applications*. No upper level of pressure for aircraft applications is taught by Deetman. Applicants are claiming the hydraulic fluids in *aircraft applications* as taught by the prior art; it has been well established that “expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected beneficial results are evidence of unobviousness.” In re Skoll, 523 F.2d 1392, 1397, 187 USPQ 481, 484 (CCPA 1975).

Applicants argue that although phosphate ester aviation hydraulic fluids were available at the time of the Deetman patent, no one used any of them in high pressure applications. This argument is not factual evidence. Unexpected results must be established by

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factual evidence; mere argument or conclusory statements do not suffice. In re Geisler, 116 F. 3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

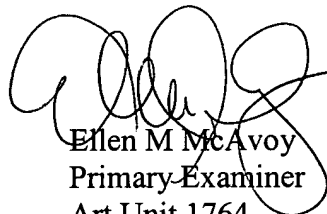
This action will not be made **FINAL** in view of the new rejection under 35 USC 112, first paragraph, included in this action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Ellen M McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
April 8, 2003